

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-3, 7, 9-12, and 16 under 35 U.S.C. § 102(b) and withdrew from consideration claims 4-6, 8, 13-15, and 17-52. As discussed in greater detail below, Applicants respectfully traverse both the Examiner's improper and unilateral withdrawal of claims 4-6, 8, 13-15, and 17-52 from consideration and the Examiner's rejection of claims 1-3, 7, 9-12, and 16. By this action, claims 1 and 32 have been amended to clarify certain features of these claims. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration of claims 1-3, 7, 9-12, and 16, reinstatement of withdrawn claims 4-6, 8, 13-15, and 17-52, and allowance of claims 1-52.

### **Election of Species Requirement**

In the Office Action mailed on July 24, 2003, the Examiner restricted examination to either claims 1-52 or claims 53-74 because “[c]laims 1-52, [are] drawn to a mechanical linkage, classified in class 403, subclass 293...[and] Claims 53-74, [are] drawn to the method of forming a modular linkage assembly, classified in class 29, subclass 592+.” See page 2, lines 1-19. In Applicants' response dated July 30, 2003, Applicants elected to prosecute the claims drawn to the mechanical linkage (1-52) and thus cancelled claims 53-74 without prejudice. Page 9, lines 9-13.

In addition, in the July 24, 2003 Office Action, the Examiner determined that “[c]laims 1, 32, and 53 are generic to a plurality of disclosed patentably distinct species,” and requested that Applicants “elect a single disclosed species” from among the species identified by the Examiner. See page 2, line 20 – page 3, line 11. In response to this request, Applicants selected the species corresponding to Fig. 8. See Applicants' Response to Office Action dated July 24, 2003, page 9, lines 12-13.

***Applicants Traverse the Election of Species Requirement***

In the present Office Action mailed on August, 17, 2004, the Examiner responded to Applicants' election. Specifically, the Examiner stated that:

Claims 4-6, 8, 13-15, 17-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species in the figures other than figure 8, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 7/30/03. Upon further review independent claim is not generic and is drawn to Figure 12. Page 2, lines 5-9

Applicants respectfully traverse the election of species requirement because the Examiner has changed his position since the last Office Action. As discussed above, in the previous Office Action, the Examiner indicated that claims 1 and 32 were "generic to a plurality of disclosed patentably distinct species." July 24, 2003 Office Action, page 2, line 20 – page 3, line 11. In reliance on this statement, Applicants elected the species corresponding to Fig. 8. In the latest Office Action, however, the Examiner decided that "[u]pon further review" claims 1 and 32 were no longer generic. Because the Examiner's change in position has necessitated Applicants' traverse, Applicants respectfully assert that the traverse is proper and has not been waived.

First, Applicants traverse the Examiner's election of species requirement because it is vague and not properly explained. In the Office Action, the Examiner stated that "[u]pon further review independent claim is not generic and is drawn to Figure 12." Page 2, lines 8-9. Applicants respectfully traverse this statement, but are unable to provide a detailed response because the statement is *so vague* that Applicants are *unable to determine* either its meaning or its effects on the present application. Applicants respectfully remind the Examiner that in accordance with 37 C.F.R. § 1.104(a)(2), the

Examiner is required to state the reasons for any adverse action or any objection. For this reason, Applicants respectfully request that the Examiner (1) state which claim is no longer considered generic; (2) explain the basis for making this determination; and (3) explain what effects the Examiner believes that this determination has on the pending claims.

Second, the Examiner's election of species requirement is improper due to a lack of *mutual exclusivity* between the various proposed species. In the July 24, 2003 Office Action, the Examiner required election of a single species from amongst a plurality of patentably distinct species comprising Figs. 4-10, 12, and 15-16. The Manual of Patent Examining Procedure states:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first.

See M.P.E.P. (Rev. 2, May 2004) §§ 806.04(f). The Examiner's election of species requirement does not appear to meet the requirements of the mutual exclusivity test set forth above. For example, Figs. 4-8 are clearly not mutually exclusive with Figs. 9-10 and 12. As such, it was improper for the Examiner to require election of one species from amongst Figs. 4-10, 12, and 15-16. For this reason, the Examiner's election of species requirement is improper and cannot stand.

Third, Applicants object to the Examiner's rejection on the ground of a lack of "serious burden" on the Examiner. As set forth in the Manual of Patent Examining Procedure, the criteria for a restriction requirement include: (1) the inventions must be

independent or distinct, and (2) there must be a serious burden on the Examiner. See M.P.E.P. (Rev. 2, May 2004) §§ 802.02 and 803. Specifically, Applicants stress that:

If the search and examination of an entire application can be made *without serious burden*, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

*Id.* at § 803. After careful review of the present application, Applicants stress that examination of all pending claims would not be a burden, much less a “serious burden,” on the Examiner. If the Examiner reviews the claims in more than a cursory manner, then Applicants believe that the Examiner will agree that the pending claims can reasonably be examined without need for the foregoing election of species requirement. For example, with regard to the election of species requirement, the Examiner has not even provided an appropriate explanation of the separate classification, or separate status in the art, or a different field of search as set forth in M.P.E.P. § 808.02. Applicants also emphasize that “[p]iecemeal examination should be avoided as much as possible.” M.P.E.P. (Rev. 2, May 2004) § 707.07(g), Page 700-122. For these reasons, Applicants respectfully request that the Examiner withdraw the restriction/election of species requirement and examine all pending claims.

Fourth, Applicants respectfully assert that it was improper for the Examiner to withdraw claims 4-6, 8, 13-15, and 17-52 because the *mere election of a species* does not give the Examiner the right to unilaterally withdraw claims. Applicants remind the Examiner that 37 C.F.R. § 1.141(a) clearly states:

Two or more independent and distinct inventions may not be claimed in one national application, *except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application*, provided the application also includes an allowable claim generic to all the claimed

species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim. (emphasis added).

If the Examiner believes that the application “contains claims directed to more than a reasonable number of species,” the Examiner does have the option under 37 C.F.R. § 1.146 to “require restriction of the claims to not more than a reasonable number of species before taking further action in the application.” However, as the record makes clear, the Examiner has not taken this step. The Examiner has *only required the election of a species*, which under 37 C.F.R. § 1.146 is clearly different.

Because the Examiner has never asked Applicants to elect claims drawn to a reasonable number of species in accordance with 37 C.F.R. §1.146, it was clearly improper for him to unilaterally withdraw claims 4-6, 8, 13-15, and 17-52 under 37 C.F.R. § 1.142(b). Further, as Applicants strongly believe that the claims 1-52 are already drawn towards a reasonable number of species, Applicants believe that it would be incorrect for the Examiner to require any further election of claims. For this reason, Applicants respectfully request that Examiner reinstate claims 4-6, 8, 13-15, and 17-52.

#### **Claim Rejections under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-3, 7, 9-12, and 16 under 35 U.S.C. § 102(b) as anticipated by Maughan et al. (U.S. Patent No. 6,059,480). Applicants respectfully traverse this rejection.

#### ***Legal Precedent***

First, Applicants remind the Examiner that, during patent examination, the pending claims must be given an interpretation that is *reasonable* and *consistent* with the specification. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); see also *In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023,

1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111. As further explained in Section 2111.01 of the M.P.E.P., the words of the claim must be given their plain meaning unless the applicant has provided a clear definition in the specification. *See In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989). Again, the plain meaning refers to an interpretation by those of ordinary skill in the art. *See In re Sneed*, 710 F.2d 1544, 218 U.S.P.Q. 385 (Fed. Cir. 1983).

Second, anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Third, Applicants respectfully remind the Examiner that “it is well established that product claims may include process steps to wholly or partially define the claimed product.” *In re Luck*, 177 U.S.P.Q. 523, 525 (C.C.P.A. 1973). To the extent that “these process limitations distinguish the *product* over the prior art, they must be given the same consideration as traditional product characteristics.” *Id.* (emphasis in original). These

claims are not product-by-process claims. A product-by-process claim defines a product by laying out the method steps required to produce the product. *See Atlantic Thermoplastics Co. Inc. v. Faytex Corp.*, 23 U.S.P.Q.2d 1481, 1490 (Fed. Cir. 1992). This is far different from a mixed limitation or hybrid claim that includes a functional limitation, but does not define the product solely by method steps. The general rule for interpreting hybrid claims is that all limitations are to be given patentable effect. *See In re Angstadt*, 190 U.S.P.Q. 214, 217 (C.C.P.A. 1976).

***Claims 1-3, 7, 9-12, and 16***

Turning to the claims, independent claim 1 recites, among other things, a “mechanical linkage, comprising an *elongated extruded member* comprising a structural cross-section and a linkage end, wherein the structural cross-section is configured to support the linkage end under a mechanical load and wherein dimensions of the structural cross-section are substantially constant in a direction transverse to the structural cross-section.” (emphasis added).

As an initial matter, Applicants traverse the Examiner’s statement in the Office Action that “[t]he extruded limitation is a product by process limitation and does not give patentable weight to the claim as long as the prior art shows the product.” Page 3, lines 11-12. The “extruded” limitation *is not* a product-by-process claim. It is part of a mixed-limitation or hybrid claim, and as stated above, each limitation of a hybrid claim should be given patentable weight. *See In re Angstadt*, 190 U.S.P.Q. 214, 217 (C.C.P.A. 1976). It was thus incorrect for the Examiner to suggest in the Office Action that “[t]he extruded limitation is a product by process limitation and does not give patentable weight to the claim.” Page 3, lines 11-12.

As stated above, independent claim 1 recites an “*elongated extruded member* comprising a structural cross-section and a linkage end.” (emphasis added). In sharp

contrast, the apparatus disclosed in the Maughan reference is clearly not an “elongated extruded member,” as recited in the instant claim. In fact, the word “extruded” is not even used in Maughan reference and careful review of the figures of the Maughan reference indicates that the shank 22 cannot be extruded because of its partially solid and partially hollow cross-section. *See* Fig. 2, 10, and 11; col. 2, lines 57-65. For example, the shank 22 has a recess 32 in its second end 30, while the remainder of the shank 22 is clearly solid. *See id.* Although this shank 22 could be a molded or machined shank 22, it clearly cannot be an extruded shank 22. For this reason alone, it is clear that the Maughan reference cannot disclose every element of the claimed invention and thus cannot anticipate independent claim 1 or the claims that depend therefrom.

In addition, independent claim 1 recites a structural cross-section “wherein dimensions of the structural cross-section are substantially constant in a direction transverse to the structural cross-section.” In contrast, the Maughan apparatus discloses a shank 22 that is clearly tapered between the first end 26 and the second end 30. *See* Figs. 1 and 2. Because the dimensions and cross-section of the shank 22 change between the first end 26 and the second end 30, the Maughan reference cannot disclose a structural cross-section as recited in independent claim 1.

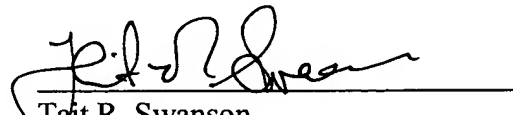
For the reasons stated above, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102.

**Conclusion**

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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